

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 2, 2002 ("Office Action"). At the time of the Office Action, Claims 1-154 were pending in this patent application. The Examiner rejected Claims 1-154. Claims 1 and 117 have been amended. Applicant respectfully submits that no new matter has been added by the amendments, as the amendments only distinctly point out elements and features already present in the Application. The amendments to the claims correct minor antecedent basis issues or clerical oversights and, as such, are not the result of any prior art reference. Thus, the amendments do not narrow the scope of the claims. Furthermore, the amendments are not related to patentability issues, only further clarify subject matter already present, and are made without prejudice or disclaimer. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Information Disclosure Statement (IDS)

Applicant hereby submits an IDS for consideration by the Examiner. Applicant asks that the Examiner review the reference submitted in the identified IDS and, further, to formally indicate that the reference was considered in the prosecution of the Application.

Section 112 Rejections

The Examiner rejects Claims 117-119 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner rejected the claims on the ground that the term "data base" in Claim 117 lacked proper antecedent basis. Applicant has amended Claim 117 in order to address the Examiner's §112 rejection. Applicant reserves the right to comment on this amendment at a future time should Applicant deem it appropriate to do so.

Section 101 Rejections

The Examiner rejected Claims 77-127 under 35 U.S.C. §101, stating that the claimed invention is directed to non-statutory subject matter. Applicant respectfully traverses this rejection for the reasons provided below.

Patent laws define patentable subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." *See* 35

U.S.C. §101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. §101. See *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q. 2d 1545, 1558 (Fed. Cir. 1994); see also *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 U.S.P.Q. 2d 1596, 1601-02 (Fed. Cir. 1998). While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. §101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. §101. See *AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding §101 and announced more expansive principles formulated with computer technology in mind); see also *In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

Applicant respectfully submits that Claims 77-127 produce a useful, concrete, and tangible result. "Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. §101." M.P.E.P. §2106. Contrary to the Examiner's statement, Claims 77-127 are not merely "directed to abstract ideas and, therefore, non-statutory subject matter." Instead, Claims 77-127 are directed to various methods of routing an object in a transportation network that include a number of limitations, which are clearly within the scope of patentable subject matter as defined by 35 U.S.C. §101. Routing an object in a transportation network provides one of a myriad of practical applications of Claims 77-127. Therefore, the rejection of Claims 77-127 under 35 U.S.C. §101 is improper, and, accordingly, Applicant respectfully requests written notice to this effect.

Election Requirement

Pursuant to 35 U.S.C. §121, the Examiner required Applicant to elect a single disclosed species for prosecution on the merits. According to the Examiner, the present application contains claims directed to four patentably distinct species, shown in: (I) FIGURE 1; (II) FIGURE 2; (III) FIGURE 3; and (IV) FIGURE 4. In response, Applicant elects the species of FIGURE 3, with traverse. Applicant contends that Claims 1-154 read on the

elected species and that a number of claims are generic, including Independent Claims 1, 39, 77, 101, and 128; this is contrary to the Examiner's contention that no claims are generic.

As indicated above, Applicant respectfully traverses the Examiner's election requirement. Applicant submits that, in contrast to the Examiner's assertion, the embodiment illustrated in FIGURE 4 is not a separate species. Instead, FIGURE 4 illustrates a method that may be applicable to each of the embodiments shown in FIGURES 1-3. For at least this reason, Applicant submits that the Examiner's requirement that Applicant make a species election between FIGURES 1-4 is improper. Moreover, Applicant submits that the Examiner's requirement that Applicant make a species election between FIGURES 3 and 4 is also improper for reasons similar to those identified supra.

Additionally, Applicant submits that a species election is unnecessary in this case for a number of other reasons. In the Office Action, (in addition to making the election requirement) the Examiner rejected all claims on the merits. This means the Examiner has already made a prior art search and examined all the claims. As such, continuing the examination of the present application and all species disclosed and claimed therein would result in no undue burden on the Examiner. For at least this reason, the Examiner's election requirement, is at minimum, unnecessary. Thus, for at least the above identified mentioned reasons, Applicant submits that the Examiner's election requirement is improper and respectfully requests that the requirement be withdrawn.

Section 102 Rejections

The Examiner rejects Claims 1-4, 6, 8, 10-11, 13-17, 23, 28-29, 39-46, 48-19, 51-55, 61, 66-67, 77-85, 88-94, 101, 104, 106-109, 128, 133-136, 139, 144, and 145 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,466,921 B1 issued to Cordery et al. (hereinafter "*Cordery*"). Applicant respectfully traverses these rejections for the following reasons.

Independent Claims 1, 39, and 101 recite, in general, obtaining, at a first point, a first address and a first functional property code associated with an object to be routed; storing, at a data base, a second functional property code, a second address, and a third address associated with a second point; determining if the first address is compatible with the second address; determining if the first functional property code is compatible with a second functional property code if the first address is compatible with the associated second address; and sending the third address to the first point if the first functional property code is

compatible with the second functional property code. In contrast to these teachings, *Cordery* discloses a system and method for evidencing postage payment that makes no mention or use of functional property codes and, further, that is incapable of producing a third address as a result of the first and second functional property codes being compatible. Additionally, *Cordery* fails entirely to disclose the use of a first functional property code associated with an object to be routed and a second functional property code associated with a second point, as is recited in the above-identified claims. Instead, *Cordery* "provides user authentication [by way of username, password, or other conventional methods]. . . to identify mailers with valid accounts." (See *Cordery*, col. 6, lines 21-27.) The username, password, or other information used to authenticate a user are neither associated with the object nor the second point, nor do they have any use in the actual routing of the object. Thus, *Cordery* fails to anticipate Independent Claims 1, 39, and 101.

In addition to lacking functional property codes, *Cordery* also fails to teach, suggest, or disclose checking the compatibility of the first and second addresses, as is recited in the above-identified claims. *Cordery* merely "determines the origin zip for the mailpiece(s), performs accounting functions and generates an encrypted evidence of postage payment, such as a token or digital signature, and sends indicium information including the token, to [a personal computer]." (See *Cordery*, col. 5, line 67 through col. 6, line 5.) Not only does this fail to check the compatibility of the first and second addresses, but two separate addresses are not even provided in the system of *Cordery*. As such, *Cordery* fails to anticipate Independent Claims 1, 39, and 101 for this additional reason.

Claims 2-38, 40-76, and 102-127 each depend from independent Claims 1, 39, and 101, respectively. Applicant respectfully submits that Claims 2-38, 40-76, and 102-127 are patentable over the cited art, for example, for at least the reasons discussed above with regard to Claims 1, 39, and 101. Notice to this effect is respectfully requested in the form of an allowance of these claims.

Independent Claim 77 recites, in general, a method for routing an object in a transportation network, comprising: obtaining, at a first point, a first address and a first functional property code associated with an object to be routed; communicating the first address and the first functional property code; and receiving a second address associated with a second point at the first point. The reasons identified above in support of the allowance of Claims 1, 39, and 101, are applicable again as *Cordery* fails to offer any teaching, suggestion, or disclosure that is even remotely related to the use of a functional property code. Therefore,

Applicant respectfully submits that Independent Claim 77 is not anticipated by *Cordery*. Claims 78-100 each depend from independent Claim 77 and, as such, Claims 78-100 are patentable over the cited art for at least the same reasons discussed above with regard to Claim 77. Notice to this effect is respectfully requested in the form of an allowance of these claims.

Independent Claim 128 recites, in general, an apparatus for routing an object in a transportation network, comprising: a memory operable to store: a first address and a first functional property code associated with an object to be routed; and second functional property code, a second address, and a third address associated with a second point; and a processor coupled to the memory, the processor operable to: receive the first address and the first functional property code; determine if the first address is compatible with the second address; determine if the first functional property code is compatible with the second functional property code if the first address is compatible with the second address; and generate a signal representing the third address if the first functional property code is compatible with the second functional property code. The reasons identified above in support of the allowance of Claims 1, 39, and 101 are again applicable as *Cordery* fails to disclose any subject matter that relates to the use of functional property codes. Thus, Independent Claim 128 is allowable over *Cordery* for at least this reason. Claims 129-154 each depend from Independent Claim 128, and, accordingly, are allowable over the cited art, for example, for the same reasons discussed above with regard to Claim 128. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

The Examiner also rejects Claims 1, 6-8, 10-11, 13-14, 17-20, 28-29, 39, 43-46, 48-49, 51-52, 55-58, 66-67, 77, 83-86, 88-93, 101-104, 106, 108-109, 112, 120-121, 128-129 and 136 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,943,658 issued to Gravel et al. (hereinafter "*Gravell*"). Applicant respectfully traverses these rejections for the following reasons.

As stated above, Independent Claims 1, 39, and 101 recite, in general, obtaining, at a first point, a first address and a first functional property code associated with an object to be routed; storing, at a data base, a second functional property code, a second address, and a third address associated with a second point; determining, at the data base, if the first address is compatible with the second address; determining at the data base, if the first functional property code is compatible with a second functional property code if the first address is compatible with the associated second address; and sending the third address to the first point

if the first functional property code is compatible with the second functional property code. In contrast to these teachings, *Gravell* discloses "a method for determining the origin ZIP code for a postage meter" for the purpose of computing the postage or shipping cost for an object. (See *Gravell*, col. 3, line 1-17.) Like *Cordery*, *Gravell* suffers from the same shortcomings in failing to teach, suggest, or disclose the use of functional property codes or anything analogous and, further, fails to offer any disclosure suggesting an ability to produce a third address as a result of the first and second functional property codes being compatible.

Contrary to the Examiner's contention, the use of a customer's phone number in *Gravell* is not a functional property code associated with an object to be shipped, or a second point (i.e., the shipping destination). The customer's phone number in *Gravell* is not used to facilitate the routing of the object as reflected by the absence of any such disclosure in *Gravell*. Instead, the customer's phone number in *Gravell* is merely used to determine "the approximate location of a postage meter improv[ing] the USPS accounting of postage metering by determining the origination ZIP code for the meter even though the meter may have been relocated from the postal zone corresponding to its licensing post office." (See *Gravell*, col. 2, lines 38-47.) As such, the customer's phone number is not a functional code and, thus, *Gravell* fails to anticipate any of the identified claims.

In addition to lacking functional property codes, *Gravell* also fails to compare a first and second address for compatibility as recited in Independent Claims 1, 39, and 101. *Gravell* merely "determines if the customer's phone number has changed from the previous call [using the Caller ID feature of the telephone system]." (See *Gravell*, col. 4, lines 41-47) This phone number is neither associated with the object to be routed, nor the second point; Applicant is perplexed to the use of this reference as it clearly does not anticipate any of the subject matter of the pending claims. Claims 2-38, 40-76, and 102-127 each depend from Independent Claims 1, 39, and 101, respectively. As such, Applicant respectfully submits that Claims 2-38, 40-76, and 102-127 are patentable over the cited art, for example, for the same reasons discussed above with regard to Claims 1, 39, and 101. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

Independent Claim 77 recites, in general, a method for routing an object in a transportation network, comprising: obtaining, at a first point, a first address and a first functional property code associated with an object to be routed; communicating the first address and the first functional property code; and receiving a second address associated with

a second point at the first point. The reasons identified above in support of the allowance of Claims 1, 39, and 101, are applicable again as *Gravell* fails to offer any teaching, suggestion, or disclosure that is even remotely related to the use of a functional property code. Therefore, Applicant respectfully submits that Independent Claim 77 is not anticipated by *Gravell*. Claims 78-100 each depend from independent Claim 77 and, as such, Claims 78-100 are patentable over the cited art for at least the reasons discussed above with regard to Claim 77. Notice to this effect is respectfully requested in the form of an allowance of these claims.

Independent Claim 128 recites, in general, an apparatus for routing an object in a transportation network, comprising: a memory operable to store: a first address and a first functional property code associated with an object to be routed; and second functional property code, a second address, and a third address associated with a second point; and a processor coupled to the memory, the processor operable to: receive the first address and the first functional property code; determine if the first address is compatible with the second address; determine if the first functional property code is compatible with the second functional property code if the first address is compatible with the second address; and generate a signal representing the third address if the first functional property code is compatible with the second functional property code. The reasons identified above in support of the allowance of Claims 1, 39, and 101 are again applicable as *Gravell* fails to disclose any subject matter that relates to the use of functional property codes. Thus, Independent Claim 128 is allowable over *Gravell* for at least this reason. Claims 129-154 each depend from Independent Claim 128, and, accordingly, are allowable over the cited art, for example, for the reasons discussed above with regard to Claim 128. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

Section 103 Rejections

The Examiner rejects Claims 5, 9, 24, 26-27, 31-38, 47, 54, 62, 64-65, 69-70, 72-75, 87, 97-99, 105, 113, 115-119, 123-126, 130-132, 140, 142-143, and 147-153 under 35 U.S.C. §103(a) as being unpatentable over either one of *Cordery* or *Gravell*. Applicant respectfully traverses this rejection for the reasons provided below.

Claims 1, 39, 77, 101, and 154, from which Claims 5, 9, 24, 26-27, 31-38, 47, 54, 62, 64-65, 69-70, 72-75, 87, 97-99, 105, 113, 115-119, 123-126, 130-132, 140, 142-143, and 147-153 depend, have already been shown to be patentably distinct from both *Cordery* and *Gravell* independently under 35 U.S.C. §102. Furthermore, the Examiner failed to cite any

references in support of his assertion that additional features of the invention, not specifically disclosed or recited in *Cordery* or *Gravell*, would fall within the level of ordinary skill in the art. Applicant also respectfully reminds the Examiner that in order to properly support a prima facie case of non-obviousness, three criteria must be met. (See M.P.E.P. §2143.) One criterion to be satisfied is that the references (alone or in combination) must disclose each of the claim limitations. However, the Examiner has still failed to offer any reference that even tangentially relates to the use of functional property codes. Thus, at least this criterion has not been satisfied. For at least this reason, Applicant respectfully submits that Claims 5, 9, 24, 26-27, 31-38, 47, 54, 62, 64-65, 69-70, 72-75, 87, 97-99, 105, 113, 115-119, 123-126, 130-132, 140, 142-143, and 147-153 are patentable over the cited art. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

The Examiner also rejects Claims 12, 21-22, 25, 30, 38, 50, 59-60, 63, 68, 71, 76, 95, 96, 100, 110, 111, 114, 119, 122, 127, 137, 138, 141, 146 and 154 under 35 U.S.C. §103(a) as being unpatentable over either one of *Cordery* or *Gravell* in view of U.S. Patent No. 4,024,380 issued to Gunn et al. (hereinafter "*Gunn*"). Applicant respectfully traverses this rejection for the following reasons.

As indicated previously, the Examiner is yet to offer any reference that teaches, suggests, or discloses the use of functional property codes. Moreover, *Gunn* does not provide any additional subject matter combinable with either *Cordery* or *Gravell* that would be material to patentability. Additionally, these claims depend from claims that have already been shown to be patentably distinct from any reference of record. Assuming *arguendo* that *Gunn* is germane to the patentability of the pending claims, examining *Gunn* more closely reveals that *Gunn* merely discloses a "self service postal apparatus and method [of] printing postage On entering or dialing the zip code of the addressee a display of the geographic location thereof assures the user that the zip code number is accurate and it may, if desired, activate a computer to computer the postage due." (See generally *Gunn*, at Abstract.) *Gunn* fails to disclose the use of functional codes or anything even analogous to such an element. As such, *Gunn* fails to provide any additional disclosure that would be material to patentability.

Additionally, Applicant notes that the Examiner has failed to offer any evidence in *Gunn* or any other reference of record, which provide any suggestion or motivation to make the proposed combinations. Moreover, the Examiner has also failed to show that proposed combination could have been based on the knowledge available to one having ordinary skill

in the art. The Examiner has also failed to identify any evidence relating to an expectation of success in making any of the proffered combinations, much less a reasonable expectation of success as is required to support a proper §103 rejection. (See M.P.E.P. §2143.) Therefore, Applicant respectfully submits that Claims 5, 9, 12, 21, 22, 24-27, 30-38, 47, 50, 54, 59, 60, 62-65, 68-76, 87, 95-100, 105, 110, 111, 113-119, 122-127, 130-132, 137, 138, 140, 141-143, and 146-154 are patentably distinct from the proposed *Cordery-Gunn and Gravell-Gunn* combinations.

Accordingly, all of the pending claims have been shown to be allowable as they are patentably distinct from the references of record. Notice to this effect is respectfully requested in the form of a full allowance of all the pending claims.

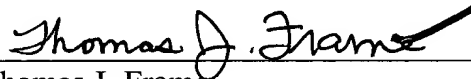
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicant hereby takes an Extension of Time under 37 C.F.R. §1.136 for responding to the Examiner's Office Action dated December 2, 2002 for two (2) months from March 2, 2003 to May 2, 2003. Applicant submits herewith a check in the amount of \$410.00 to cover the two (2) month Extension of Time fee, and a check in the amount of \$180.00 for the IDS.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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